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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,329	03/26/2004	Valery Levitan	WH-11 979US	8232
24962 7590 07/18/2007 DENNISON ASSOCIATES 133 RICHMOND STREET WEST SUITE 301 TORONTO, ON M5H 2L7 CANADA			EXAMINER SHAH, MILAP	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,329

Applicant(s)

LEVITAN ET AL.

Examiner

Milap Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on March 28, 2003. It is noted, however, that applicant has not filed a certified copy of that application as required by 35 U.S.C. 119(b).

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be **material to patentability as defined in 37 CFR 1.56**.

The current oath or declaration appears to have an incorrect duty to disclose statement.

Drawings

The drawings are objected to because at least each figure does not appear to proper under 37 CFR 1.84, for at least the reason that the figures do not appear to be clearly reproducible, such that every line, number, and letter must be durable, clean, black, sufficiently dense and dark, and uniformly thick and well defined (figures 1-6). Additionally, at least figure 1 contains numerous text phrases that are fairly illegible and the text size for these phrases is very small. 37 CFR 1.84 states that numbers, letters, and reference characters must be at least 0.32cm. Finally, for the reason of consistency, the Examiner requests the Applicant to use typed numeral numbers, as the current drawings have both typed and written numerals. The hand-written numerals convey informal drawings. Therefore, the Examiner respectfully suggests and

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requests the Applicant to re-file each figure in at least a clearer more-detailed manner, avoiding excessive shadowing/shading as well.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. At least claim 8 recites "sweepstakes mode",

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however, the specification does not appear to describe what exactly happens during a sweepstakes mode, that is, how is the game play, fees, payouts, etc, different in a sweepstakes mode. Only a single sentence could be located in the specification that appears to hint at the fact that in sweepstakes mode, the player is paying a fee to play, however, no payout is discussed. Therefore, for at least these reasons, the Examiner submits that a sweepstakes mode is not enabled. For purposes of examination, the Examiner interprets a sweepstakes mode to be a mode in which the player must pay a wager amount or fee to play the downloaded game.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At least claim 4 recites the limitation "said web browser" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. The Examiner suggests modifying the dependency of claim 4 from claim 3 rather than claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11, & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al. (U.S. Patent Application Publication 2002/0068629, hereafter "Allen").

Claim 1: Allen discloses the same invention including a personal portable device (paragraph 0019-0023) to be carried by a user and having a primary practical function and a secondary personal entertainment function, said primary practical function including the capability to communicate over a communication network with a separate computer (figure 1[communication network 104 & other computers/servers 108] & paragraph 0022), said secondary personal entertainment function includes a series of downloaded games downloaded to said personal portable device using said communication capability of said primary practical function to connect with a game server computer and have said game server computer download at least one additional game (figure 1[game server 102] & paragraph 0037), said at least one additional game including as part thereof a tracking arrangement for tracking use information (figure 2[token 246] & paragraphs 0032-0033) with respect to the play of said at least one game and to communicate said use information to said game server computer when said personal portable device is in communication (figure 6[uploading the information stored in token 246 at step 610] & paragraph 0052) with said game server computer (see also figures 1-6, abstract, & summary of invention at paragraphs 0008-0010).

Claim 2: Allen discloses a wide variety of devices may be used, where the portable device may include hand-held devices, where he gives the example of palm-pilots (i.e. a PDA) or laptops, and it is known in the art that both a PDA and a laptop are capable of being used as a portable telephone or cell phone via a wireless communication link. The claimed "cell phone" does not appear to limit the device to any particular hand-held device other than one that is capable of making a phone call and having a browser. Allen further discloses the client devices having browsers to enter URLs of the game server to obtain games (figure 2[browser program 240] & paragraphs 0026 & 0030).

Claim 4: Allen clearly discloses the limitations of claim 4 in at least figure 4, where a user must register (i.e. create an account) if the user does not already have an account (figure 4[steps 406 & 408]). Then, Allen discloses that the user is able to download a game program and also communicate usage information (i.e. send and receive said information) stored in token 246 (figure 4[steps 422-426]). In the situation that there is only one registered user, Allen discloses communicating collective usage information of that one registered user at least in the eighth field of token 246 (figure 3[games played 316]).

Claim 11: Allen discloses the portable device may be a personal data assistant and further discloses intermediate devices (figure 1[intermediate device 114]) that could be computers usable to facilitate connection between the end user device being the personal data assistant and the game server (see at least figure 1 & paragraph 0024).

Claim 12: See 35 U.S.C. 112, first paragraph rejection above, in which the Examiner submitted an interpretation of “sweepstakes mode”. Allen discloses providing a game where a player must make a wager to play the game, where the act of playing a wager to play the game discloses the game is in a “sweepstakes mode” where a fee is charged to play the game. Allen also discloses downloading a plurality of games (paragraph 0037). Thus, at least some of these games are playable in a “sweepstakes mode”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen, as applied to claims 1-4, 11, & 12, where applicable, in view of Tsuda et al. (U.S. Patent No. 6,174,236).

Claims 5 & 6: Allen discloses the invention substantially as claimed except for explicitly disclosing that collective use information is displayed on the display device (figure 2[output device 238]), however, Tsuda et al. disclose displaying everyone's score on each display device of each connected game system (abstract), thus, collective use information is essentially displayed on the display device of the game system. Tsuda et al. provide motivation to add such a feature to other game systems by disclosing that in current gaming systems at the time of his invention it was impossible for a user on one game device to have knowledge of the scores of other players, who may be in other facilities, and the position said user's score amongst the other users' scores. The game usage information is considered to be received from the game server. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Allen with the teachings of Tsuda et al. in order to facilitate displaying all users' scores to each user to allow users to gauge their own position amongst all the scores.

Claim 7: Allen disclosing downloading a "series" of games, where the series is based on gambling games, such as blackjack, roulette, or poker (paragraph 0037).

Claim 8: See 35 U.S.C. 112, first paragraph rejection above, in which the Examiner submitted an interpretation of "sweepstakes mode". Allen discloses providing a game where a player must make a wager to play the game, the wager dependent on his account information (i.e. the wager is removed from money stored in accordance with his account information) and the number of times the player would like to play the game (paragraph 0008 discloses the game token has gaming credit against which a user may place a gambling bet in the downloaded games).

Claims 9 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen & Tsuda et al., as applied to claims 5-8, where applicable, further in view of Acres (U.S. Patent Application Publication No. 2001/0034643).

Claims 9 & 10: The combination of Allen & Tsuda et al. discloses the invention substantially as claimed except for explicitly disclosing advertisements during game. Such a feature is well known in the gaming art, however, Acres explicitly teaches a method and system for advertising during game play (abstract & figure 1 of Acres) even when the device is not connected to a network (i.e. the Internet). Acres provides the motivation to include such a feature by discussing that advertisements could be used to generate compensation for the game provider thereby allowing the game provider to offer higher awards, the cycle thus encouraging players to click advertisements to fuel higher awards (paragraphs 0006-0008 of Acres). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combination of Allen & Tsuda et al. with the teachings of Acres for at least the reason of generating higher revenues from advertising for a game provider and generating higher award payouts based on the higher revenues achieved.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Name</u>	<u>Reference</u>	<u>Applicability</u>
MacInnis	U.S. Patent No. 5,951,639	Downloading of software and data modules of compatible versions to devices.
LaDue	U.S. Patent No. 5,999,808	A wireless gaming method.
Henry et al.	U.S. Patent Application Publication No. 2001/0046854	Method of remotely updating the software of a mobile telephone.
Matsuura et al.	U.S. Patent Application Publication No. 2002/0072411	A game terminal device (i.e. a mobile phone).
Nagashima	U.S. Patent Application Publication No. 2002/0082088	Discusses gaming with a mobile device.
Washio	U.S. Patent Application Publication No. 2003/0003994	Game providing server and game providing system (discloses using a mobile device).

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Levitan	U.S. Patent No. 6,514,139 U.S. Patent No. 6,860,808	Both appear to be Applicant's prior inventions, where the disclosure of the first patent appears to read on some of the instant application. The first patent appears to be eligible as prior art under 102(b) as being more than one year before the effective filing date of the instant application (March 26, 2004).
Rautilla	U.S. Patent No. 6,524,189	Multi-player game system using mobile telephones and game units.
Thomas	U.S. Patent Application Publication No. 2003/0046356	Mobile gaming.
Narita	U.S. Patent No. 6,733,392 U.S. Patent No. 6,761,638	Mobile terminal and a method for controlling games.
Wells et al.	U.S. Patent No. 6,805,635	Method for downloading data to gaming devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.B.S.



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